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09/676,805	09/29/2000	Joseph R. Stonoha	632.0001USU	2958

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3639

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,805

Applicant(s)

STONOKA ET AL

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

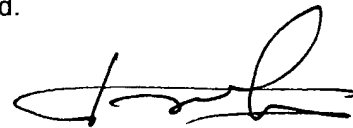
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



IGOR N. BORISSOV
PRIMARY EXAMINER

Continuation of Disposition of Claims: Claims pending in the application are 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81.

Continuation of Disposition of Claims: Claims rejected are 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81.

DETAILED ACTION***Response to Amendment***

Amendment received on 10/29/2004 is acknowledged and entered. Claims 2-4, 8, 9, 11-13, 16-18, 20-22, 32, 36, 43, 47, 54, 58 and 61-72 have been canceled. New claims 76-81 have been added. Claims 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The clear definition of “ad hoc job” and “serial job” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Independent claim 73 recite the following limitation: “determining if a current job is an ad hoc job or a serial job”. However, the terms “ad hoc job” and “serial job” are neither defined in the claim, nor explained in Specification in such a way to enable one of ordinary skill in the art to clear understand the differences between said “ad hoc job” and “serial job”, and make a determination of *if said current job is an “ad hoc job” or “a serial job”*.

Specification, page 8, lines 19-27, gives the following explanation of “ad hoc job”:

“An ad hoc job includes a variety of different labels that may or may not be related. For instance, an ad hoc job may include replacement labels for an existing set of labels. Some of these labels will bear no ordered sequential relation to other labels in

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the job. However, the ad hoc job is versatile enough to include a group of labels that have an ordered sequence."

While said explanation sounds confusing, Specification does not provide any indication at all what "serial job" is. Specification, Page 10, lines 16-25 explains only what will happen if the user selects a "serial job".

Therefore, the disclosure is not enabling.

Same reasoning is applied to all independent claim and remaining dependent claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 73 recites the following limitation: "determining if a current job is an ad hoc job or a serial job", which is confusing. The terms "ad hoc job" and "serial job" are neither defined in the claim, nor explained in Specification. It is not clear how one of ordinary skill in the art can make a determination of if said current job is an "ad hoc job" or "a serial job" if the definition of said jobs are not provided.

Specification, page 8, lines 19-27, gives the following explanation of "ad hoc job": "An ad hoc job includes a variety of different labels that may or may not be related. For instance, an ad hoc job may include replacement labels for an existing set of labels. Some of these labels will bear no ordered sequential relation to other labels in the job. However, the ad hoc job is versatile enough to include a group of labels that have an ordered sequence."

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While said explanation sounds confusing, Specification does not provide any indication at all what “serial job” is. Specification, Page 10, lines 16-25 explains only what will happen if the user selects a “serial job”.

Furthermore, independent claim 73 recite the following limitation: “if the current job is an ad hoc job, presenting *one or more* ad hoc display screens for a user *to define an ad hoc job that includes a variety of labels having different content, some of the labels of said ad hoc job being unrelated to other labels of said ad hoc job*”, which is confusing. It is not clear should the following information, which is not positively claimed, be given patentable weight: “*to define an ad hoc job that includes a variety of labels having different content, some of the labels of said ad hoc job being unrelated to other labels of said ad hoc job*”. Furthermore, the term *unrelated* is confusing. It is not clear what type of relationship is considered: based on content or type of work, for example. Specification does not provide clear definition of said term. Furthermore, the phrase “presenting *one or more* ad hoc display screens” is confusing; it is not clear how many display screens actually presented. For purposes of examination Examiner will understand said phrase as “presenting *at least one of* ad hoc display screens”.

Furthermore, independent claim 73 recite the following limitation: “if the current job is a serial job, presenting one of more serial display screens for a user *to define a serial job that includes a plurality of labels having different content and related to one another in a sequential fashion*”, which is confusing. It is not clear should the following information, which is not positively claimed, be given patentable weight: “*to define a serial job that includes a plurality of labels having different content and related to one another in a sequential fashion*”. This information appears to be a recitation of possible results of the recited *presenting* step, and adds nothing to the patentability of the claim.

Moreover, the phrase “*related to one another in a sequential fashion*” is confusing. It is not clear what does the phrase “*a sequential fashion*” actually contemplates.

The term *related* is confusing. It is not clear what type of relationship is considered: based on content or type of work, for example.

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The phrase: "a plurality of labels *having different content* and related to one another" is confusing. It is not clear what the word "*different content*" relates to: different in respect to each other inside the serial job, or content of all labels in the serial job is different than content of all labels in ad hoc job. If different in respect to each other inside the serial job, than how these labels relate to each other?

Same reasoning are applied to all independent claim and remaining dependent claims.

Independent claim 75 recites the following structural limitations: "first means for controlling said computer", "second means for controlling said computer", "third means for controlling said computer" and "fourth means for controlling said computer", which is confusing, because the claim is directed to a product. Therefore, there is insufficient antecedent basis for said limitations.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 14, 15, 19, 23, 24, 39-42, 44-46, 48-53, 55-57, 59, 60, 74-77, 80 and 81 are rejected under 35 U.S.C. 101 because each of said claims includes more than one statutory classes of invention.

Independent claim 74 includes two statutory classes of invention: an apparatus (a computer), and a product (a computer-readable medium having a program/instructions stored herein for causing the computer to perform a recited method steps).

It must be clear from the wording of a claim that it is drawn to one or the other of mutually exclusive statutory classes of invention. A claim drawn to apparatus must distinguish in terms of structure. *Ex parte Lyell at 1552.*

Same reasoning are applied to independent claim 75 which includes two statutory classes of invention: a computer-readable medium having a program/instructions stored herein for causing the computer to perform a recited method steps, and an apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura et al. (US. US 5,448,685).

Claims 73-75. Ogura et al. (hereinafter Ogura) teaches a computer-implemented method, system and computer-readable medium having instructions for performing said method, for forming labels with a computer in response to entries from an input device, comprising:

determining if a current job is an ad hoc job (new formation) or a serial job (continuation) (Figs. 8A, 8B, #14 and #16; C. 9, L. 33-60);

if the current job is an ad hoc job, presenting one or more ad hoc display screens for a user to define an ad hoc job that includes a variety of labels having different content, some of the labels of said ad hoc job being unrelated to other labels of said ad hoc job (Figs. 8B – 37);

if the current job is a serial job, presenting one of more serial display screens for a user to define a serial job that includes a plurality of labels having different content and related to one another in a sequential fashion (Figs. 8B – 37);

responsive to at least one entry of said entries, printing either said ad hoc

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job or said serial job (Figs. 8B – 37).

Ogura does not explicitly teach that said new formation job is ad hoc job, and that said continuation job is serial job.

However, Specification does not provide neither clear definition of said ad hoc job and serial job, nor any indication of advantages of using said specific terminology over the teachings of the prior art.

Without such indication it appears that the use of said specific terminology would be an obvious variation of any technical terminology suitable for the task.

Claims 1, 5-7, 10, 14, 15, 19, 23, 24, 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59 and 76-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura et al. in view of Best et al. (US 5,533,176).

Claims 1, 5-7, 10, 14, 15, 19, 23, 24, 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59 and 76-81. Ogura teaches all the limitations of claims 1, 5-7, 10, 14, 15, 19, 23, 24, 28-31, 33-35, 37, 39-42, 44-46, 48, 50-53, 55-57, 59 and 76-81, including that the text and graphics to appear on a label is automatically scaled to fit the printable area of a designated label, except specifically teaching that the "positional palette" or the size, rotation and appearance of any text and graphic that is to appear at each of the specific printable locations on the label may be designated by the user.

Best et al. (hereinafter Best) teaches a computer-implemented method, system and computer-readable medium having instructions for performing said method, for forming labels with a computer in response to entries from an input device, comprises generating and printing various labels that contain both text and graphics, wherein the control processor of the label generating and printing machine, while executing the operating program, that is stored in the memory, permits the user to design one or more labels by designating at each printable location on a label the "positional palette" or the size, rotation and appearance of any text or graphic that is to appear at each of the specific printable locations on the label. After the user has finished designing labels, the user may make further selection of the labels that will be printed as a print job on the

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printer that is associated with the label generation machine or method (Fig. 1; C. 4, L. 41 – C. 8, L. 20).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogura to include that the "positional palette" or the size, rotation and appearance of any text and graphic that is to appear at each of the specific printable locations on the label may be designated by the user, as disclosed in Best, because it would advantageously enhance the functionality of the system, thereby make it more attractive to the customers.

As per claims 30, 31, 41, 42, 52 and 53, it would have been obvious to one having ordinary skill in the art at the time the invention was made to recognize that the character to be printed could be a "prefix" or "suffix" relative to any of the other characters to be printed on a label, because the meaning of the words "prefix" and "suffix" would be understood by one of ordinary skill.

Claims 38, 49 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura et al. in view of Best et al. further in view of Drisko (US 4,718,784) and further in view of Benada et al. (US 5,621,864).

Claims 38, 49 and 60. Ogura in view of Best teach all the limitations of claims 38, 49 and 60, including designating by the user a sequence of numbers to be placed on a label, except specifically teaching saving data for said ordered numerical sequence and plurality of labels so that another plurality of labels can continue in said ordered numerical sequence with a first label thereof having the next number of said ordered numerical sequence that succeeds the last number used by the step of assigning an ordered numerical sequence.

Drisko teaches a computer-implemented method and system, which under the control of an operating program stored in a memory, performing the functions of permitting an user to design one or more labels and then designate which of the designed labels are to be printed as a single print job on an supply of labels stock containing label that are arranged in one or rows and columns, wherein said system

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includes a control processor, memory, display, input device and printer and configured to permit the user to enter information that would:

- for each label to be designed to define/designate for each printable character position/location on each label being designed the one or more alphanumeric characters, for example, text and serial numbers, or graphics, for example, a barcode, that is to appear on the label at each of the printable position/location on the label;

- for each printable character position/location on each label being designed to designate a customized pallet that would designate the font size to be used, and

- whether the character is to appear using bold print for each printable character position/location, where the pallet;

- for each designed label by the user, to designate the quantity of labels to be printed in a print queue/job as well as the order/sequence in which the designated labels are to be printed in the print queue/job; and

- permit the user to place a label serial number on a label;

- based on the entered information, displaying for preview on a display the designed label including the relative positions of the alphanumeric/graphical content of the label;

- wherein when the print queue/job is to be printed as indicated by an entry from the user, the designated labels would be printed beginning on a designated label, for example the first available label, on the label stock, and then serially on each available label in the rows/columns of labels on the label stock; and

- wherein once the user has designated the appearance of a character/graphic, said designated appearance would be used for each sequential printable location on the label until a new appearance of a character/graphic was designated (Figs. 1-8b).

However, Drisko does not specifically teach saving the last serial number used so that the next label to be designed that includes a label serial number would use the next available succeeding serial number.

Benada et al. (hereinafter Benada) teaches a computer-implemented method, system and computer-readable medium having instructions for performing said method, for forming labels with a computer in response to entries from an input device,

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comprising keeping track of the last unique indicia in the sequence of unique indicium that has been used so that no two labels would be potentially confused with one another, since both labels would have the same unique identifier.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Drisko to include keeping track of the last unique indicia in the sequence of unique indicium that has been used so that no two labels would be potentially confused with one another, since both labels would have the same unique identifier, as disclosed in Benada, because it would advantageously allow to avoid confusion caused by having two labels with the same serial number confused as the same label.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ogura and Best to include the ability to place unique serial numbers on labels and to remember the last serial number used as taught by Drisko in view of Benada, because it would advantageously allow to avoid confusion caused by having two labels with the same serial number confused as the same label.

Response to Arguments

Applicant's arguments with respect to claims 1, 5-7, 10, 14, 15, 19, 23-31, 33-35, 37-42, 44-46, 48-53, 55-57, 59, 60 and 73-81 have been considered but are moot in view of the new ground(s) of rejection.

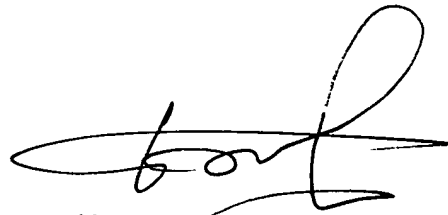
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6/25/2006



IGOR N. BORISSOV
PRIMARY EXAMINER